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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/334,054	06/15/1999	DAVID W. JOHNSON	11381	4885

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EXAMINER
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NOLAN, SANDRA M

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 05/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/334,054

Applicant(s)

JOHNSON, DAVID W.

Examiner

Sandra M. Nolan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22, 25 and 31-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-12, 20-22, 25 and 31-35 is/are rejected.
- 7) ☒ Claim(s) 6-9 and 14-19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claims***

1. Claims 1-22, 25, and 31-35 are pending.

### ***Withdrawal of Allowance***

2. The allowance of claims 6-9 and 14-19 is withdrawn in order to apply the new objection/rejection set out herein.

### ***Allowable Subject Matter***

3. Claim 13 is allowed. The prior art of record fails to teach or suggest surface modified articles having electrically conductive colloidal silica particles attached to, but not extending through their surfaces.
4. Claims 6-9 and 14-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Withdrawal of Rejection***

5. The 35 USC 102 rejection of claims 1-5, 10-12, 20, 22, 25, 31, 32, 34 and 35 as anticipated by Katoot (US 5,932,299), as recited in section 6 of the 15 October 2002 office action (Paper No. 19), is withdrawn in order to apply the new 35 USC 103 rejection set out herein.

### ***New Rejections***

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1772

7. Claims 1-5, 10-12, 20-22, 25, and 31-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

What does "at least certain" mean? How are the "certain" particles selected? How does one insure that none of the "certain" particles are completely embedded in the outside surface?

It is suggested that the phrase "at least certain" be deleted from: claim 1, penultimate line; claims 12 lines 4-5; and claim 31, penultimate line.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1-5, 10-12, 20-22 and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoot in view of Rudness (US 3,787,229).

Katoot is discussed in section 6 of Paper No. 19. It fails to teach the partial embedding of silica particles in its surface layers.

Rudness teaches wear resistant surface layers containing spherical/spheroidal particles partially embedded in a matrix (abstract). The particles are silica (col. 2, lines 67-68). The matrix is rubber (col. 3, line 34). The layers are applied by conventional means (col. 3, lines 59-61). Rudness teaches that the articles having the layers of its invention have wear resistance (abstract).

The patents are analogous because they both deal with articles having silica-containing surface layers.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the partially-embedded silica particles of Rudness when making the gloves of Katoot in order to attain wear resistance properties.

The motivation to employ the partially-embedded silica particles of Rudness when making the gloves of Katoot is found in Rudness' abstract, where the wear resistance of Rudness' articles is discussed.

It is deemed desirable to make gloves having wear resistance in order to reduce the likelihood of holes/tears forming in the gloves during use.

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1-5, 10-12, 20-22 and 31-35 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 1772

***Citation as of Interest***

12. Lasch (US 5,536,569) is cited as of interest for showing skid-resistant particles (abstract), which can be silica (col. 6, line 63), in polymeric pavement marking sheets.

***Conclusion***

Any inquiry concerning this communication should be directed to the Examiner, Sandra M. Nolan, whose telephone number is 703/308-9545. The Examiner can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the Examiner by telephone are unsuccessful, her supervisor, Harold Pyon, can be reached at 703/308-4251. The general fax number for the art unit is 703/305-5436. The fax number for after final communications is 703/872-9310. The receptionist answers 703/308-0661.



S. M. Nolan  
Patent Examiner  
Technology Center 1700

SMN/smn  
09334054(22)  
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